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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,162	09/04/2003	George A. Locko	921042.449	6804

1726 7590 06/06/2006

INTERNATIONAL PAPER COMPANY
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LOVELAND, OH 45140

EXAMINER

ZEMEL, IRINA SOPHIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,162

Applicant(s)

LOCKO ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-22 and 25-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The base claims 21, 37 and 40 recite the ratios of the reactants as 50:50 or greater. The language greater is an open end language that includes all of the ratios up to 100:0. The applicants disclosure only provides support for that ranges of the claimed ratios of from about 40:60 to about 60:40 as per the broadest disclosure on pages 8-9 of the instant specification.

Claim Rejections - 35 USC § 103

Claims 21-24 and 27-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmer of record in combination with Hawley's Condensed Chemical Dictionary, eleventh edition, page 1015, (hereinafter "Dictionary").

The rejection stands as per reasons of record.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmer in combination with the Dictionary as applied to claims 21 and further in combination with Irie of record.

The rejection stands as per reasons of record.

Response to Arguments

Applicant's arguments filed March 24, 2006 have been fully considered but they are not persuasive. The applicants argue that none of the cited references disclose the claimed ratio of rosin (R) to terpene-phenol (TP) greater than about 50:50 or greater. While this may be so, obviousness of choosing of any R:TP ratio was expressly discussed in the previous office actions. The examiner maintains her position that in the absence of showing of criticality of the claimed ratio ranges, the claimed ratios would have been obvious from the disclosure of Lemmer. The applicants further state that the claimed ratios are critical and provide unexpected results as supported by the Exhibit 1 provided by the applicants. The evidence of the alleged unexpected results are not persuasive. The applicants state that employing a rosin:terpene-phenol weight ratio of about 50:50 or greater results in producing adhesive formulations having much greater contact cement peel (lb/inch) as compared to those adhesive formulations containing resins made under conditions outside the claimed invention (e.g. when the rosin:terpene-phenol weight ratio is less than 50:50). This statement plainly contradicts the showings of exhibit 1. As shown on the graph, the contact cement peel DECREASES (NOT INCREASES) when the ratio of rosin to terpene-phenol increases from 50:50 to 70:30. See for example peel of 15.1 and 17.9 for compositions having 70:30 and 65:35 as compared to 44.2 of compositions with 50:50 ratio, and more importantly, as compared to peel of 52.5 for compositions with 35:65 R:TP ratio, which is OUTSIDE of the claimed range, and, in fact, a lot closer to the ratio of 38.5:61.5 as

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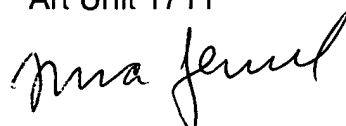
expressly disclosed in the Lemmer's illustrative examples than to the claimed lower limit of 50:50 R:TP ratio. Thus, the arguments regarding unexpected results provided by the claimed ratios are not found persuasive and further, the arguments are NOT supported by the very exhibit relied upon in the arguments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel
Primary Examiner
Art Unit 1711



ISZ